

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB 10/6/98

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Simple Shoes, Inc.

v.

Jay Mohseni

Opposition No. 101,627
to application Serial No. 74/577,971
filed on September 26, 1994

Paul Juettner of Juettner Pyle Lloyd & Piontek for Simple
Shoes, Inc.

Kenneth Roberts of Lyon & Lyon LLP for Jay Mohseni

Before Simms, Cissel and Chapman, Administrative Trademark
Judges.

Opinion by Chapman, Administrative Trademark Judge:

An application has been filed by Jay Mohseni to
register the mark SIMPLE BY DESIGN on the Principal Register
for "headwear, hats, t-shirts, sweatshirts, shorts,

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swimwear, pants, jeans, jackets, sweaters, overalls, skirts, blouses, coats, pajamas, sleepwear, pullovers, headbands, wristbands, underwear, cardigans and socks.”¹ The application was based on intent to use.

Registration has been opposed by Simple Shoes, Inc. pursuant to Section 2(d) of the Trademark Act. In support of its opposition, opposer asserts that it has continuously used the mark SIMPLE on footwear and t-shirts since December 1991, and has continuously used the mark in interstate commerce on said goods since March 13, 1992; and that applicant’s mark, if used on his goods, would so resemble opposer’s previously used and registered mark, SIMPLE, for “men’s women’s and children’s casual and athletic shoes and t-shirts”² as to be likely to cause confusion, mistake, or deception.

Applicant filed an answer in which he admits that his mark has not been used in commerce, but he otherwise denies the salient allegations of the notice of opposition³.

The record consists of the pleadings; opposer’s notice of reliance on printed publications, product packaging⁴, a

¹ Appl. Ser. No. 74/577,971, filed September 26, 1994.

² Reg. No. 1,805,363, issued November 16, 1993.

³ Applicant asserted the untimeliness of the opposition as a “defense” in his answer to the notice of opposition. The record shows that on February 12, 1996 opposer filed a timely request to extend its time to oppose until April 15, 1996. The Board granted said request in an order dated March 19, 1996. The notice of opposition was timely filed on April 12, 1996.

⁴ The Board notes that opposer’s product packaging is not appropriate material for submission through a notice of reliance

status and title copy of opposer's pleaded registration, and applicant's amended objections and answers to certain of opposer's first set of interrogatories to applicant; and the testimony depositions (with exhibits) of Eric Meyer, opposer's founder, and Jalalh Mohseni⁵, applicant.⁶

In this case opposer has filed a status and title copy of its pleaded registration. Because opposer owns a valid and subsisting registration of its mark, the issue of priority does not arise. See *King Candy Company v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974); *McDonald's Corp. v. McClain*, 37 USPQ2d 1274 (TTAB 1995); and *Humana Inc. v. Humanomics Inc.*, 3 USPQ2d 1696 (TTAB 1987).

Thus, the sole issue before the Board is likelihood of confusion. Based on the record before us in this case, we find that confusion is likely.

under Trademark Rule 2.122(e). However, applicant specifically did not object to this evidence, stating that the only evidentiary disputes related to certain objections to testimony. Accordingly, we have considered the packaging to be of record. See TBMP §708. In any event, opposer's product packaging is not of significance in deciding this case.

⁵ Both parties refer to this testimony deposition as that of "applicant, Jay Mohseni".

⁶ In their briefs on the case, both parties stated "there are no evidentiary disputes other than occasional objections to trial testimony, which objections are noted in the transcripts of Eric Meyer and Jay Mohseni." The parties did not renew any specific objection in their briefs on the case. Even if the above-quoted broad statement is construed as a renewal of all objections, the Board will not rule on each of those few objections separately. None of the individual objections by either side, separately or collectively, is critical to the determination of this case.

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The testimony of Eric Meyer establishes that he founded the opposer corporation in December 1991 (Dep., p. 10), and that the initial products made and offered to the public under the mark SIMPLE by opposer were shoes, t-shirts, hats, decals, and stickers (Meyer Dep., p. 11). Opposer currently sells a wide variety of products other than shoes, including, hats, caps, socks, sweatshirts, wallets, key chains, stickers, backpacks, and messenger bags (Dep., pp. 13-16 and 28). Mr. Meyer testified that opposer sells its goods nationwide and worldwide through retailers ranging from large department stores such as Nordstrom's and Macy's West to the smallest surf shop (Dep., pp. 13 and 33), and through mail order catalogs of companies such as REI and Sundance (Dep., p. 32), and that opposer also sells its shoes in shoe stores such as Athlete's Foot, Foot Locker, Lady Foot Locker, and Track and Trail (Dep., p. 33). He further testified that opposer's goods are promoted through opposer's sponsorship since December 1991 of various teams such as surf teams, snowboard teams, and skateboard teams, as well as sponsorship of a number of other athletes who compete in the fields of mountain biking, water-skiing, downhill skiing, etc. (Dep., p. 18). Opposer advertises its goods in magazines such as Rolling Stone, Wired, Spin, Details, Surfer, and Transworld Skateboarding (Dep., p. 19); as well as through a website (Dep., p. 19); at large concert

tours; a poetry festival in Portland, Oregon; and at film festivals, such as the New York International Film Festival (Dep., pp. 19-20). Mr. Meyer specifically testified that t-shirts and shoes have been sold continuously since opposer's inception in December 1991 (Dep., p. 27).

Opposer's sales figures (domestically) are \$800,000 (5% non-shoe sales) for 1992; \$1.6 million (5% non-shoe sales) for 1993; \$12 million (5% non-shoe sales) for 1994; \$19 million (5% non-shoe sales) for 1995; and \$26 million (7.5% non-shoe sales) for 1996 (Dep., pp. 31-32).

Eric Meyer testified that the meaning of, or the philosophy behind, opposer's mark, SIMPLE, is "maintaining a clean lifestyle," and "not falling prey to the hype of the 1990's." (Dep., p. 22). In further explaining, Mr. Meyer stated the motivating force in his founding of Simple Shoes, Inc. was that he "was having a lot of trouble finding shoes that I liked. Many of the shoes were, you know, offering things that I didn't want. And I was looking for shoes that were classics from the past, and at the same time I wanted the type of comfort which was available in an athletic shoe." (Dep., pp. 23-24).

Applicant, Jay Mohseni, testified that he met with Mr. Meyer in San Diego to discuss a possible joint business venture regarding the SIMPLE trademark, but no agreement was reached (Dep., pp. 10-12); that before selecting his mark

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SIMPLE BY DESIGN, a search was conducted, revealing several registered marks that included the word SIMPLE, such as SIMPLE LIFE (stylized), SIMPLE ADDITION, SIMPLESSE, SIMPLEE ALONE (stylized), PURE & SIMPLE, SIMPLE PLEASURES, and SIMPLE MINDS, all for goods which included items of clothing; and that he believed anyone could use the word SIMPLE (Dep., p. 12).

As to the meaning of his mark, Mr. Mohseni testified that he added the words "BY DESIGN" to indicate that the product was "designed simple to go out there, just your basic colors,, classic styles," keeping simplicity in mind "to create a product line which would be timeless and ageless." (Mohseni Dep., p. 13).

He also testified that he intends to use his mark on various items of apparel, not including shoes (Dep., pp. 16-17), and that he will not sell to shoe stores (Dep., p 18). He intends to sell his goods to department stores, such as Nordstrom's, Macy's, the Federated chain, and Allied Stores, clothing stores; specialty stores; through catalogs; and on the Internet (Dep., p. 32-34). In his amended answers to opposer's interrogatories, he responded that he intends to advertise in "national magazines publications, on the internet, and on television." (No. 5).

This record clearly establishes opposer's continuous use of the mark SIMPLE on clothing, namely shoes and t-

shirts, since December 1991, with sales through department stores, specialty stores, and mail order catalogs. It is also clear that applicant intends to sell a variety of clothing items, including t-shirts. Applicant's argument that opposer is predominantly a shoe company is not persuasive because, even if the majority of opposer's sales are for shoes, the t-shirts identified in opposer's registration must be deemed legally identical to the t-shirts identified in applicant's application. Moreover, t-shirts are closely related to, inter alia, the sweatshirts, pants, jeans and other specific clothing items in applicant's application. See *In re Kangaroos U.S.A.*, 223 USPQ 1025 (TTAB 1984); *B. Rich's Sons, Inc. v. Frieda Originals, Inc.*, 176 USPQ 284 (TTAB 1972); and *The United States Shoe Corp v. Oxford Industries, Inc.*, 165 USPQ 86 (TTAB 1970). Thus, the parties' respective goods are in part identical, and many are otherwise related.

As a result, the goods of opposer and applicant which are deemed to be legally identical must also be deemed to be sold in the same channels of trade. Moreover, it is clear from the testimony of both parties that once applicant commences use of his mark, he intends to sell through channels of trade identical to those of opposer, such as department stores, specialty stores and catalogs. Further, the application contains no limitation as to channels of

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trade and we must, therefore, presume that the goods move through all of the normal channels of trade for goods of this type. See *The Chicago Corp. v. North American Chicago Corp.*, 20 USPQ2d 1715 (TTAB 1991).

Turning to the marks, opposer's mark is SIMPLE and applicant's mark is the word SIMPLE plus the words BY DESIGN. Thus, the marks are in part identical. The connotations of the respective marks, SIMPLE and SIMPLE BY DESIGN, are quite similar, as testified to by both applicant and opposer. Specifically, both connote the idea of a simple, classic, timeless and/or ageless product.

Purchasers may assume that SIMPLE BY DESIGN is just an extension of opposer's line of products sold under the mark SIMPLE, including shoes, clothing, and other items. That is, consumers may see applicant's mark as a mere variation of opposer's mark, SIMPLE. The addition of the words BY DESIGN is insufficient to distinguish the marks because overall they are substantially similar in commercial impression. (Applicant did not argue or testify that the addition of the words BY DESIGN was intended to indicate these were clothing items designed by a specific designer.)

Moreover, where a newcomer has appropriated the entire mark of a registrant, and has added to it a non-distinctive term or otherwise subordinate matter, the marks are generally considered to be confusingly similar. See *Spoons*

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Restaurants Inc. v. Morrison Inc., 23 USPQ2d 1735 (TTAB 1991), aff'd unpub'd, Appeal No. 92-1086 (Fed. Cir. June 5, 1992); In re Denise, 225 USPQ2d 624 (TTAB 1985); and The Proctor & Gamble Company v. Glamorene Products Corporation, 188 USPQ2d 704 (TTAB 1975), aff'd at 190 USPQ2d 543 (CCPA 1976).

Applicant testified that he requested a search; and that there were several third-party registrations which include the word SIMPLE in some form (Dep., p. 12); and opposer's witness, Eric Meyer was questioned as to his knowledge of third-party marks (Dep., pp. 51-54 and 58-59). From this applicant argued that there is extensive third-party use of the word SIMPLE or a variant thereof on related goods; and that when questioned on these registered marks, opposer testified that these marks were in use on the goods, such as lingerie, t-shirts and hats, thereby admitting the use of these third-party marks. Essentially, applicant is arguing that SIMPLE is a weak mark which is not entitled to a broad scope of protection, basing his claim on the third-party registrations revealed by the search he conducted. However, applicant is incorrect in his interpretation of the testimony of opposer, and in his reliance on the registrations alone. [In fact, applicant testified that he did not have any evidence of use of the various third-party marks (Dep., pp. 28-30).] Mr. Meyer was asked if he was

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aware of certain registrations, to which he answered "yes" or "no", and he was asked if he believed that there was a likelihood of confusion between the third-party marks and opposer's mark. This is not testimony as to use of the marks, nor does it constitute an admission that the registered marks are in use. Third-party registrations are not evidence of use of the marks, or what happens in the marketplace, or that consumers are familiar with the third-party marks. See *Olde Tyme Foods Inc., v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542, 1545 (Fed. Cir. 1992); and *Spoons Restaurants Inc. v. Morrison Inc.*, *supra*, at 1740. Thus, there is no evidence of record as to uses of similar marks on similar goods. While third-party registrations may be used to show the significance of a mark regarding weakness, applicant's mark is closer to opposer's mark than any of the registered third-party marks. That is, applicant's mark is the word SIMPLE with the additional words BY DESIGN. The third-party registrations indicate that the word SIMPLE (or some form thereof) has been registered with other words for a variety of clothing items, but applicant has not proven that opposer's mark SIMPLE is a weak mark.⁷

⁷ Applicant also argues in the brief on the case that opposer acknowledges its mark SIMPLE should not be entitled to a broad scope of protection because during the testimony of Eric Meyer, opposer admitted "that a lack of strong public awareness of Simple Shoes and what the brand represents has prevented Simple

Finally, opposer argued that applicant's motive in adopting his mark and applicant's intent to trade on opposer's mark are relevant in this case. The record shows that applicant contacted Eric Meyer at the offices of opposer, Simple Shoes, Inc., to commence a joint venture or to do business together under the mark SIMPLE; that the two men spoke on the phone and met at a trade show in San Diego in August 1994; that applicant wrote a proposal dated September 6, 1994; and that no agreement to do business together was ever reached. (Mohseni Dep., pp. 9-12).

While the record is clear that applicant knew of opposer and opposer's mark, SIMPLE, there is no convincing evidence of bad faith by applicant. Mere knowledge does not necessarily amount to bad faith in adopting a mark.

Nonetheless, a party which knowingly adopts a mark similar to one used by another for the same or closely

shoes from expanding into the apparel arena." (Appl's brief, p. 14). Opposer takes issue with this assertion in that when asked whether opposer had plans to further expand its line of products, Eric Meyer testified, "yes"; and that opposer has been looking at "other clothing products than we have currently". (Meyer Dep., p. 28-29). In explaining the timetable for this, he stated that opposer needs "to develop our brand to an extent that we feel the public has a strong awareness of Simple Shoes and what the brand represents. And as they see the logo, they know immediately what-- they know immediately it's Simple Shoes and what we're all about. And when we feel that that point has come, we will then come out with the apparel line." (Meyer Dep., p. 29). The Board disagrees with applicant's argument that this testimony constitutes an admission that opposer's mark is entitled to a narrow scope of protection and that opposer's mark lacks strong public awareness. As indicated above, the third-party registrations and opposer's statements do not show that opposer's mark is a entitled to only a narrow scope of protection.

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related goods does so at its peril and any doubt on the question of likelihood of confusion must be resolved against the junior user. See *Kenner Parker Toys Inc. v. Rose Art Industries Inc.*, 963 F.2d 350, 22 USPQ2d 1453 (Fed. Cir. 1992); *J & J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 18 USPQ2d 1889 (Fed. Cir. 1991); *In re Hyper Shoppes (Ohio) Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988); *First International Services Corp. v. Chuckles, Inc.*, 5 USPQ2d 1628, 1633 (TTAB 1988); and *Roger & Gallet S.A. v. Venice Trading Co. Inc.*, 1 USPQ2d 1829, 1832 (TTAB 1987).

Based on the close similarity of the marks, the identity or close relationship of the goods, and the identity of the trade channels, confusion is likely between applicant's mark and opposer's mark, when these marks are used on the respective goods of the parties.

Decision: The opposition is sustained, and registration to applicant is refused.

R. L. Simms

R. F. Cissel

B. A. Chapman
Administrative Trademark
Judges, Trademark Trial and
Appeal Board